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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/016,325	12/10/2001	Bryan C. Dunkeld	KOP 2001-1	4756
23694 7590 11/12/2008 J. NICHOLAS GROSS, ATTORNEY 2030 ADDISON ST. SUITE 610 BERKELEY, CA 94704				
EXAMINER				
AUGUSTIN, EVENS J				
ART UNIT		PAPER NUMBER		
3621				
MAIL DATE		DELIVERY MODE		
11/12/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/016,325

Applicant(s)

DUNKELD ET AL.

Examiner

EVENS J. AUGUSTIN

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07/07/08.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22-37.55 and 59-80 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 22-37.55 and 59-80 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date 06/25/08 and 08/22/08
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Affidavit or Declaration Under 37 CFR 1.131

1. The declaration filed on 07 July 2008 under 37 CFR 1.131 has been considered and has been found to overcome the O'Kane cited reference. New grounds of rejection are in order - therefore, applicant's arguments filed on 07 July 2008 are moot.
2. Claims 22-37, 55 and 59-80 are pending.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Regarding claims 22, 24, 25, 27, 35, and 37, the phrase "and/or" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d). The primary purpose of this requirement of definiteness of claim language is to ensure that the scope of the claims is clear so the public is informed of the boundaries of what constitutes infringement of the patent. In this case, the language of "and/or" does not make clear whether the succeeding language is included, as part of the limitation or it is in the alternative. This language does not inform the public of the boundaries of what constitutes infringement of the patent. For example in claim 22, it not clear whether the second computer is included in the limitation or is an alternative to the first computer.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 22-37, 55 and 59-80 are rejected under 35 U.S.C. 102(e) as being anticipated by Levy (U.S. 20020052885).
7. As per claims 22-37, 55 and 59-80, Levy discloses an invention that comprises of the following:
- A. ("a first computer coupled to the network, said first computer storing a digital asset which includes both digital content and a first unique identifier associated with a first instantiation of said digital asset") – A first computer (par. 77, Fig. 1, item 104) storing digital content or asset (par. 77), being part of a P2P network (72, 17);
- B. ("a second computer coupled to the network") -- A second computer (par. 77, Fig. 1, item 106) storing digital content or asset (par. 77), being part of a P2P network (72, 17);
- C. ("a first software routine executing on said first computer and/or said second computer, said first software routine being adapted to coordinate transfer of said digital asset to said second computer;") – a search program running on peer computers (par. 31, 74, 77). Peer computers also run a file sharing application, managing/coordinating file transfer (par. 84-99);

- D. ("said second computer operate to transfer said digital asset in a peer to peer manner across the Internet") – Peer computers being part of a P2P network (72, 17), using the internet (par. 23);
- E. With regard to the aspect of ("wherein after said transfer, a second transfer of said digital asset can occur from either said first computer and/or said second computer, said second transfer further using a third instantiation of said digital asset and a third unique identifier") –multiple transfer or instantiation of the same can take place across a P2P network (par. 72);
- F. ("second computer is a portable electronics device, including a personal computer, a personal digital assistant, and/or a telephone") – Portable device (par. 12);
- G. ("said digital content includes an MP3 based audio file") – MP3 files (par. 65, 66, 77);
- H. ("unique identifier is based on combining information from any one or more of the following: a first id for said first computer, a second id for said second computer, an asset id for said digital asset, a customer id, a randomly generated number and/or a time of said transfer") -- Unique ID based on content (par. 34, 36);
- I. ("a catalog of available digital assets is maintained at said first computer.") – Clients maintain a database of file available for download (par. 77);
- J. ("first software routine is also configured to execute an authorization routine, said authorization routine being adapted to secure agreement from a user of said second computer to access terms associated with said digital asset") – a user interface to the client that informs the user of file transfer rights, and gives the user the opportunity to get rights that he or she desires (Par.81,83);

- K. ("setup routine being adapted to set up a transaction account with a digital asset management system separate from said first computer and said second computer, said transaction account including an identifier for a user of said second computer, identifiers for any transfers performed by said user, and billing information associated with said transfers") – The system allows the user to set up subscription accounts (43, 83).
Therefore, it is adapted to set up payment account;
- L. ("Track all transfers of digital assets from said first computer.") – Tracking of content (par. 32, 128);
- M. ("receives credits from said digital asset management system for all authorized transfers made of digital assets")—Means to account for all file transfers, and be used to properly pay or give credit to the rights holders (par. 33, 43);
- N. ("second computer polls other computers coupled to the network to determine an optimal transfer source for said digital asset") – Requesting or polling other computers (par. 007, 30, 31 117);
- O. ("content includes content for a newspaper, a book, a magazine, and/or a periodical") – Content can be MP3 files, software, documents, images, video, etc.(par. 77) -- newspaper, a book, a magazine, and/or a periodical fall under the document category;
- P. ("second instantiation of said digital asset is created in accordance with distribution rules in place at the time of said transfer, which distribution rules can be different from distribution rules in place at the time of creation of said first instantiation of said digital asset ") – checking the rights/rules to transfer or copy or download or instantiate (81);
- Q. ("second computer is integrated within a fixed personal entertainment system, including a gambling machine, a digital jukebox, and/or a passenger seat ") -- Output device

containing personal digital jukeboxes such a media player, such as Windows Media Player, Real Player from Real Networks, WinAmp (par. 121);

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to EVENS J. AUGUSTIN whose telephone number is 571-272-6860. The examiner can normally be reached on 10am - 6pm M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Fischer can be reached on (571)272-6779.

/Evens J. Augustin/
Evens J. Augustin
November 12, 2008
Art Unit 3621